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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GOLLAMUDI, SHARMILA S	
ART UNIT	**PAPER NUMBER**
1616	

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/435,576	CHEN ET AL.	
	Examiner	Art Unit	
	Sharmila S. Gollamudi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13,18,19,21,22,25-29,31-54,57-71 and 76-81* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13, 18-19, 21-22, 25-29, 31-54, 57-71, and 76-81* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of Amendments and Remarks filed May 9, 2005 is acknowledged. Claims **1-13, 18-19, 21-22, 25-29, 31-54, 57-71, and 76-81** are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13, 18-19, 21-22, 25-29, 31-54, 57-71, and 76-81 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the amendment of 5/9/05 applicant deleted the phrase "about"; however a careful review of the specification does not provide support for this. For instance, the instant specification provides a Tmax of **about** 10 to 32 hours wherein the specific range of 10 to 32 hours is not contemplated. The limitation removing "about" in claim 76, 77, and 80 also is not supported. If applicant contends there is support for such an amendment, the examiner requests the applicant point to the specific page and line where support may be found.

The rejection of claims 2, 9, 21-22, 25-26, and 71 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendment of 5/9/05.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 1-5, 7-13, 18-19, 21-22, 25-26, 28-29, 33-37, 39, 41, 43, 76-77, and 80 under 35 U.S.C. 102(b) as being anticipated by Cheng et al, Evaluation of Sustained/Controlled Release dosage forms of 3-Hydroxy-3-Methylglutaryl-Coenzyme A (HMG-CoA) Reductase Inhibitors in Dogs and Humans, Pharmaceutical Research (19923), 10:1683-1687 is withdrawn in view of the amendment of 5/9/05. However, it should be noted that this rejection will be reinstated once the applicant removes the new matter.

Claims 1-13,18, 19, 21, 22, 25-54, 57-71 and 76-81 are rejected under 35 U.S.C. 102(b) as being anticipated by Alberts et al (5,376,383).

Alberts discloses a method of lowering plasma cholesterol levels by administering to a subject a time-controlled drug-delivery device containing a water-soluble HMG-CoA reductase inhibitor (lovastatin, pravastatin, etc). Alberts discloses that using a sustained or controlled release provides for a single dose to yield an equivalent or improved effect as that of a rapid release formulation (col. 1, lines 39-50 and abstract). Additionally, the formulation lowers the amount of peak drug plasma concentration in the blood; thus the potential side effects of the drug are reduced. The controlled release is over a 6 to 24 hour period (col. 2, line 63). Alberts discloses that this controlled release can be achieved by a variety of procedures known to those

skilled in the art and discloses various controlled released matrices in the examples. The procedures suitable for the invention are diffusion-controlled systems, osmotic devices, dissolution controlled matrices, and erodible/degradable matrices (col. 3, lines 1-2). Lastly it should be noted that lovastatin hydrolyzes in vivo to form its acid form, lovastatin acid. The examples provide a controlled device comprising a core and coat, which is substantially similar to instant disclosure Table 1's general formula.

* Note that although the prior art does explicitly state the instant functional limitations, it is the examiner's position that the instant functional limitation is inherent since Albert's example 10 provides a release rate over an 18 hour period. Thus, the Tmax would inherently fall within instant range. The recitation of a newly discovered function inherently possessed by the prior art, does not make distinguish it form the prior art. Further, it is the applicant's burden to prove otherwise. See In re Best, 195 USPQ 430 (CCPA 1977).

Response to Arguments

Applicant argues that Alberts does not inherently provide the instant Tmax and inherency requires that the Tmax must be necessarily present.

Applicant's arguments filed 5/9/05 have been fully considered but they are not persuasive. The examiner recognizes that inherency requires that an element must be necessarily be present, however as noted in *In re Best*, 195 USPQ 430 (CCPA 1977) the Patent Office can require the applicant to prove that a subject matter shown in the prior art does not possess a characteristic when there is reason to believe that the functional limitation asserted to be critical in establishing novelty in the claimed subject matter is possessed by the prior art. The burden is *initially* on the examiner to provide a rationale for inherency, which then shifts to the applicant to

rebut the examiner's position with evidence since the United States Patent Office does not have the capabilities or the facilities to test products for inherent features. See MPEP 2112. In instant case, the examiner refers to Table 1 in the instant disclosure to provide the rationale. Applicant discloses that the general structure in Table 1 provides the instant functional limitations. A careful look at Table I demonstrates that the instant invention only requires a core and an outer coating. The seal coat, an inner coat, and overcoat are not required since the claimed range encompasses zero. Zero clearly implies that the coating is not required. Therefore, examiner points out that the instant structure as defined in Table 1 and that of the prior art are substantially the same used for the same purpose. See the examples in Alberts. According to the MPEP, "A rejection under 35 U.S.C. 102/103 can be made when the prior art product **seems** to be identical except that the prior art is silent as to an inherent characteristic." The examiner therefore suggests that the applicant provide a Rule 132 declaration that compares the instant invention's Tmax and that of the prior art to rebut the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The rejection of claims 1-13,18, 19, 21, 22, 25-48, 70-71, 76-77, and 80 under 35 U.S.C. 103(a) as being unpatentable over Klimistra et al (5,668,134) is withdrawn in view of applicant's arguments of 5/9/05.

The rejection of claims 48-54, 57-69, 78-79 and 81 under 35 U.S.C. 103(a) as being unpatentable over Klimistra et al (5,668,134) in view of Alberts et al (4,997,658) is withdrawn in view of applicant's arguments of 5/9/05.

The rejection of claims 48-50, 58-59, 62-63, 65-66, 68-70, 71, 78-79, and 81 under 35 U.S.C. 103(a) as being unpatentable over Cheng et al, Evaluation of Sustained/Controlled Release dosage forms of 3-Hydroxy-3-Methylglutaryl-Coenzyme A (HMG-CoA) Reductase Inhibitors in Dogs and Humans, Pharmaceutical Research (19923), 10:1683-1687 is withdrawn in view of view of the amendment of 5/9/05. However, it should be noted that this rejection will be reinstated once the applicant removes the new matter.

The rejection of claims 1-13,18, 19, 21, 22, 25-54, 57-71 and 76-81 under 35 U.S.C. 103(a) as being unpatentable over Alberts et al (4,997,658) in view of Chen et al (5,558,879) is withdrawn in view of the arguments of 5/9/05.

Claims 1-13,18, 19, 21, 22, 25-29, 31-54, 57-71 and 76-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 5,837,379 to Chen et al.

Chen et al disclose a once daily pharmaceutical tablet having a 1) compressed core contains a medicament, a water-soluble osmotic compound, and one or more osmotic polymers, and 2) a membrane coating containing a water insoluble pharmaceutically acceptable polymer and an enteric polymer. See abstract. Although nifedipine is exemplified, Chen teaches various water-insoluble medicaments that may be utilized, including instant lovastatin. See column 2, line 64. The composition may additionally have dispersants, lubricants, dyes, and other additives that are conventionally utilized in the art. See column 5, lines 63-65. More specifically, Chen et al teach the medicament granules contain nifedipine, povidone (osmotic polymer), lactose (osmotic agent), and sodium lauryl sulfate (surfactant). The granules are compressed with lactose, Polyox WSR, and Myvaplex and coated with a color coating contains dye, sodium chloride, and water. The color coating is coated with a sustained release coating; followed by an enteric coating containing HPMC phthalate, pore forming agent, talc, and plasticizer. See examples. Lastly it should be noted that lovastatin hydrolyzes in vivo to form its acid form, lovastatin acid.

Chen does not exemplify lovastatin in the controlled release device nor specify the instant functional limitations.

It is deemed obvious to one of ordinary skill in the art at the time the invention was made to look to the guidance provided by Chen et al and include the instant lovastatin in the controlled release dosage form. One would have been motivated to do so since Chen teaches a variety of medicaments that would benefit from the use of the instant controlled release formulation and

teaches the instant active as one of the suitable medicaments. Therefore, one could reasonably expect similar results by including lovastatin in Chen's controlled release device.

Furthermore, it is the examiner position that the instant controlled release device would meet the instant functional limitations since Chen's controlled release device is similar in structure and formulation to applicant's dosage form described in the specification; in particular Table 1. Therefore, it is the examiner's position that both would function similarly if not the same since the structures of the instant invention and that of the prior art are the same.

Response to Arguments

Applicant argues that Chen et al is directed to a controlled release dosage form but teaches various drugs including the instant lovastatin, fluvastatin, simvastatin, or pravastatin. However, applicant argues that the only in-vivo data provided is not related to the instant HMG-CoA Reductase Inhibitors. Applicant argues that none of the examples or information is provided for the instant HMG-CoA Reductase Inhibitors. Applicant argues there is not statement of the Tmax and there is not suggestion that the in-vivo plasma levels achieved in the example of Chen would be desired for the instant drug class.

Applicant's arguments filed 5/9/05 have been fully considered but they are not persuasive. Firstly, the examiner recognizes that HMG-CoA Reductase Inhibitors are suggested and not exemplified. Hence, the examiner makes the rejection under obviousness and as applicant is well aware, in an obviousness rejection, the prior art need only suggest the instant invention. In instant case, Chen is generally directed to a controlled release device for a once-a-day administration for water-insoluble drugs including the instant HMG-CoA Reductase Inhibitors, to increase patient compliance. See column 2, lines 64-65. Although the

pharmokinectics of nifendipine are exemplified, a skilled artisan one would have been motivated to substitute nifendipine with the instant lovastatin and expect similar pharmacokinetic values since Chen clearly suggests the use of other drugs in place of nifedipine. Furthermore, it should be noted that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

Secondly with regard to Chen's lack of the teaching of a Tmax or recognition of the criticality of the Tmax, it is pointed out that there is no requirement that a skilled artisan in the art has to recognize inherent properties at the time of invention, the only requirement is that that the subject matter is in fact inherent in the prior art reference. Schering Corp. v. Geneva Pharm. Inc., 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003). As set forth in the rejection above, it is the examiner's position that Chen's controlled device would inherently provide the instant Tmax. The rationale is as follows: The examiner points out that Chen teaches a core containing the drug, povidone (a water-swellable polymer), an osmotic agent (lactose), and sodium lauryl sulfate (surfactant) in applicant's amount disclosed in Table I. The core is coated with a color coating containing a dye and sodium chloride (osmotic agent). The prior art's color coat is comparable to applicant's seal coat. Then a sustained release coating containing Eudragit S (enteric polymer), and a plasticizer in applicant amount disclosed in Table I. The prior art's sustained release coat is comparable to applicant's inner coat. Lastly, the tablet is again coated with an enteric coating polymer containing an enteric polymer, a pore-forming agent (channeling agent), acetyltributyl citrate (plasticizer). The prior art's enteric coat is comparable to applicant's overcoat. Therefore, it can be seen that this device is the same as the described in instant

specification of the preferred controlled release device that provides functional limitations of the instant application. Thus, it is the examiner's position that Chen's controlled release device would function similarly. It is pointed out that the examiner has provided a rationale that the prior art would function the same; thus the burden has shifted to applicant to prove otherwise. As noted in *In re Best*, the Patent Office can require the applicant to prove that a subject matter shown in the prior art does not possess a characteristic when there is reason to believe that the functional limitation asserted to be critical in establishing novelty in the claimed subject matter, is possessed by the prior art. As required the examiner has provided a rationale for inherency and thus the burden has shifted to the applicant. The examiner suggests the applicant compare Chen's device with the instant invention to substantiate applicant's arguments.

For the reasons above, the rejection is maintained.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13, 18, 19, 21, 22, 25-47, 76-77, and 80 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,485,748. Although the conflicting claims are not identical, they are

not patentably distinct from each other because since they encompass similar subject matter. It should be noted that the rejection of claim 48-54, 57-71, 78-79, and 81 over 6,485,748 is withdrawn. It should also be noted that the rejection of 5,916,595 is withdrawn in view of the Terminal Disclaimer filed 3/9/01.

US '748 is directed to a controlled release oral solid dosage form containing a compressed core with a slightly soluble medicament and a membrane coating. The specification defines lovastatin as a drug that is slightly soluble.

Instant application is directed to a controlled release oral solid dosage form for the reduction of serum cholesterol levels containing lovastatin and a controlled release carrier wherein the said dosage form has certain functional limitations upon consumption of the said dosage form.

Although US patent does not claim the functional limitation as seen in instant application, the controlled dosage form of US patent '595 would function in a similar manner as instantly claimed dosage form since both claim the same drug and the same controlled release structure. Although US patent '748 recites a generic slightly water-soluble drug, the specification defines lovastatin as a drug that falls within this category. Thus, the instant application and US patents are related genus-species, wherein instant application recites the species and falls within the generic scope of the US patents '595 and '748.

Response to Arguments

Applicant argues that US ' '748 do not claim or teach a controlled dosage form that with the instant Tmax. Applicant will file a Terminal Disclaimer over the claims of US 5,916,595 once the instant claims have been found allowable.

Applicant's arguments filed 5/9/05 have been fully considered but they are not persuasive. With regard to US '748, '748 also claims the same structure and claims the medicament is a slightly to practically insoluble in water at 25 degrees Celsius. The specification defines lovastatin as a drug that falls into this definition. Thus, the claims of instant application and US '748 have overlapping subject matter. Again claiming a functional limitation of a product does not change the product itself; thus the instant product and US patent are obvious over each other. It should be noted that the rejection of claims 48-54, 57-71, 78-79, and 81 over '748 are withdrawn since '748 claims a controlled release device and not the method of reducing serum cholesterol levels.

With regard to 5,916,595, it should be noted that the rejection over '595 is withdrawn since the applicant filed a Terminal Disclaimer March 9, 2001, which was inadvertently overlooked by the examiner.

Claims 1-13, 18, 19, 21, 22, 25-47, 76-77, and 80 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 09/435576. Although the conflicting claims are not identical, they are not patentably distinct from each other because they encompass similar subject matter. It should be noted that the rejection of claim 48-54, 57-71, 78-79, and 81 is withdrawn.

Instant application is directed to a controlled release oral solid dosage form for the reduction of serum cholesterol levels, containing lovastatin and a controlled release carrier wherein said dosage form has certain functional limitations upon consumption of the dosage form.

Co-pending application is directed to a controlled release oral solid dosage form for the reduction of serum cholesterol levels, containing alkyl ester of hydroxyl substituted napthalenes and a controlled release carrier wherein said dosage form has certain functional limitations upon consumption of the dosage form. Lovastatin is claimed in an independent claim.

Although both instant application and co-pending application are directed to different functional limitations, both applications are claiming the same type of dosage form, containing the same active agent, and are used for the same purpose. Furthermore, the instant application and co-pending application have a genus-species relationship wherein instant application recites the species, which falls within the scope of co-pending application recitation of the generic HMG-CO-Reductase Inhibitors. Therefore, the instant application and co-pending application claims encompass similar subject matter with obvious modifications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant will file a Terminal Disclaimer over the claims of copending application once the instant claims have been found allowable. Thus, the examiner holds the rejection is abeyance until the instant claims are allowed.

Conclusion

All the claims remain rejected at this time.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary Kunz

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Sharmila S. Gollamudi
Examiner
Art Unit 1616